

DETAILED ACTION

1. Claims 1-38 have been examined. Application 09/988,333 (AWARD POINT SERVICE SYSTEM, RECORDING MEDIUM FOR USE THEREIN AND AWARD POINT SERVICE METHOD) has a filing date 11/19/2001 and foreign priority 11/20/2000.

Response to Amendment

2. In response to Non Final Rejection filed 05/01/2008, the Applicant filed an Amendment on 07/31/2008, which amended claim 37.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-38 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Said claims recite first memory that only stores data of points issued to customer in at least one virtual store on the network and a second memory that only stores data of the points issued to the customer in at least one actual store". The Applicant's specification does not explain how to system is able to distinguish between points that come from a virtual store from points that come from an actual store and to differentiate between memories.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1, 19 and 37 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1 and 19 recite "first memory that only stores data of points issued to customer in at least one virtual store on the network and a second memory that only stores data of the points issued to the customer in at least one actual store". For purpose of art rejection, said limitation would be interpreted as storing points in a network server (i.e. virtual store) and in smart card memory (i.e. actual store). Claims 1 and 19 recite "the first memory and the second memory are associated with the same company". For purpose of art rejection, said limitation would be interpreted as meaning as storing points in a first and second memories where said points are related to a same issuer's company.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Postrel (US 6,594,640) in view of Taylor (US 5,578,808).

Claim 1, Postrel teaches:

An award point service system, comprising:

a network comprising:

a point issuing device that issues points to a customer who purchases an article (see col 9, lines 55-65);

a first memory that only stores data of the points issued to the customer (see col 9, lines 55-65) in at least one virtual store on the network (see col 4, lines 5-40);

wherein the at least one virtual store established on the network is accessible to the point issuing device (see figure 4); and wherein the at least one actual store is accessible to the point reducing device (see col 9, lines 55-65 “vender associated with a computer connected to the Internet”). Postrel fails to teach a second memory that only stores data of the points issued to the customer in at least one actual store; a data access permitting device that permits the data of the points issued to the customer to be read from the first and second memories; and a point reducing device that allows use of at least a part of the points read from the first and second memories by subtracting the at least part of the points from the data of the points stored in the first and second memories. However, Taylor teaches a smart card that stores point information from a plurality of vendors in different memories areas linked to said vendors and where said points are used as payment for purchases (see col 3, lines 20-40; col 7, lines 35-50). Therefore, it would have been obvious to a person of ordinary skill in the art at the time

the application was made, to know that Postrel's smart card would have a plurality of memories which would store point information from a plurality of vendors, as taught by Taylor in order to link awarded points with the issuing vendor of said awarded points and use said awarded points from different vendors as payment for purchases.

wherein the first memory and the second memory are associated with a same company (see Postrel "Airline Reward server" and airline miles would be added to a smart card"; col 9, lines 55-65)

Claim 2, Postrel teaches:

wherein the at least one actual store is accessible to the point issuing device (see col 9, lines 55-65).

Claim 3, Postrel teaches:

wherein the at least one virtual store is accessible to the point reducing device (see col 4, lines 4-45).

Claim 4, Postrel teaches:

wherein the at least one virtual store is accessible to the point reducing device (see col 4, lines 4-45).

Claim 5, Postrel teaches:

A managing device that manages the points issued by the point issuing device and the points reduced by the point reducing device (see col 4, lines 5-45).

Claim 6, Postrel teaches:

a managing device that manages the points issued by the point issuing device and the points reduced by the point reducing device (see col 4, lines 5-45).

Claim 7, Postrel teaches:

a managing device that manages the points issued by the point issuing device and the points reduced by the point reducing device (see col 4, lines 5-45).

Claim 8, Postrel teaches:

a managing device that manages the points issued by the point issuing device and the points reduced by the point reducing device (see col 4, lines 5-45).

Claim 9, Postrel teaches:

wherein the data access permitting device comprises a terminal provided in the actual store (see col 9, lines 55-65), and the terminal receives the data of the points from a recording medium owned by the customer and supplies the recording medium with the data of the points (see col 9, lines 55-65).

Claim 10, Postrel teaches:

wherein the data access permitting device comprises a terminal provided in the actual store, and the terminal receives the data of the points from a recording medium owned by the customer and supplies the recording medium with the data of the points (see col 9, lines 55-67).

Claim 11, Postrel teaches:

wherein the data access permitting device comprises a terminal provided in the actual store, and the terminal receives the data of the points from a recording medium owned by the customer and supplies the recording medium with the data of the points (see col 9, lines 55-67).

Claim 12, Postrel teaches:

wherein the data access permitting device comprises a terminal provided in the actual store, and the terminal receives the data of the points from a recording medium owned by the customer and supplies the recording medium with the data of the points (see col 9, lines 55-67).

Claim 13, Postrel teaches:

wherein the data access permitting device comprises a terminal provided in the actual store, and the terminal receives the data of the points from a recording medium owned by the customer and supplies the recording medium with the data of the points (see col 9, lines 55-67).

Claim 14, Postrel teaches:

wherein the recording medium comprises a medium used for making a payment (see col 9, lines 55-65).

Claim 15, Postrel teaches:

wherein the terminal is a point of sale (POS) terminal (see col 10, lines 1-10).

As per claim 16, Postrel teaches:

wherein the terminal is a credit authorization terminal (CAT) (see col 10, lines 1-10).

As per claim 17, Postrel teaches:

a credit company that issues credit to the customer comprising:

a first credit company memory for storing data of the points issued to the customer in virtual stores (see col 5, lines 45-55; "credit card server capable of holding a user's earned rewards");

a credit company virtual server connected to the first credit company memory that is configured to communicate with the at least one virtual store (see figure 4, item 12); and

Postrel fails to teach a second credit company memory for storing data of the points issued to the customer in an actual store;

a credit company actual server connected to the second credit company memory that is configured to communicate with the at least one actual store,

wherein the customer can purchase items from the at least one virtual store and the at least one actual store with credit (see col 10, lines 1-15).

However, Taylor teaches a smart card that stores point information obtained from a plurality of actual vendors obtained from purchases made using a credit card (see col 6, lines 1-10). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Postrel's credit card server would have a plurality of memories which would store point information from a plurality of credit card issuers, being said points obtained from actual or virtual stores, as taught by Taylor in order to link awarded points with the issuing vendor of said awarded points and use said awarded points from different vendors as payment for purchases.

Claim 18, Postrel teaches:

an information processing center communicatively connected to the credit company actual server and credit company virtual server that processes purchases made under credit by the customer wherein the credit company actual server

communicates with the at least one actual store via the information processing center (see col 10, lines 1-10).

Claim 19, Postrel teaches:

An award point service system, comprising:

a network comprising:

a point issuing device that issues points to a customer who purchases an article (see col 9, lines 55-65);

a first memory that only stores data of the points issued to the customer (see col 9, lines 55-65) in at least one virtual store (see col 9, lines 55-65);

a data access permitting device that permits the data of the points issued to the customer to be read from the memory (see col 9, lines 55-65), and

a point reducing device that allows use of at least a part of the points read from the memory by subtracting the at least part of the points from the data of the points stored in the memory (see col 9, lines 55-65); wherein the at least one virtual store established on the network is accessible to the point reducing device (see col 4, lines 1-45); and wherein the at least one actual store is accessible to the point issuing device (see col 9, lines 55-65). Postrel fails to teach a second memory that only stores data of the points issued to the customer in at least one actual store. However, Taylor teaches a smart card that stores point information from a plurality of vendors in different memories areas linked to said vendors and where said points are used as payment for purchases (see col 3, lines 20-40; col 7, lines 35-50). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to

know that Postrel's smart card would have a plurality of memories which would store point information from a plurality of vendors, as taught by Taylor in order to link awarded points with the issuing vendor of said awarded points and use said awarded points from different vendors as payment for purchases.

wherein the first memory and the second memory are associated with a same company (see Postrel "Airline Reward server" see figure 4; see Taylor figure 1 "airlines").

Claim 20, Postrel teaches:

wherein the at least one virtual store is accessible to the point issuing device (see col 4, lines 1-45).

Claim 21, Postrel teaches:

wherein the at least one actual store is accessible to the point reducing device (see col 9, lines 55-65).

Claim 22, Postrel teaches:

a credit company that issues credit to the customer comprising:

a first credit company memory for storing data of the points issued to the customer in virtual stores (see col 5, lines 45-55; "credit card server capable of holding a user's earned rewards");

a credit company virtual server connected to the first credit company memory that is configured to communicate with the at least one virtual store (see figure 4, item 12 and 30); and

Postrel fails to teach a second credit company memory for storing data of the points issued to the customer in an actual store;

a credit company actual server connected to the second credit company memory that is configured to communicate with the at least one actual store,

wherein the customer can purchase items from the at least one virtual store and the at least one actual store with credit.

However, Taylor teaches a smart card that stores point information from a plurality of vendors in different memories areas linked to said vendors and where said points are used as payment for purchases (see col 3, lines 20-40; col 7, lines 35-50). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Postrel's credit card server would have a plurality of memories which would store point information from a plurality of vendors, being said vendors actual or virtual stores as taught by Taylor in order to link awarded points with the issuing vendor of said awarded points and use said awarded points from different vendors as payment for purchases.

Claim 23, Postrel teaches:

wherein the data access permitting device comprises a terminal provided in one of the at least one actual store, and the terminal receives the data of the points from a recording medium owned by the customer and supplies the recording medium with the data of the points (see col 9, lines 55-65).

Claim 24, Postrel teaches:

wherein the data access permitting device comprises a terminal provided in one of the at least one actual store, and the terminal receives the data of the points from a recording medium owned by the customer and supplies the recording medium with the data of the points (see col 9, lines 55-65).

Claim 25, Postrel teaches:

wherein the data access permitting device comprises a terminal provided in one of the at least one actual store, and the terminal receives the data of the points from a recording medium owned by the customer and supplies the recording medium with the data of the points (see col 9, lines 55-65).

Claim 26, Postrel teaches:

wherein the recording medium comprises a medium used for making a payment (see col 9, lines 55-65).

Claim 27, Postrel teaches:

A computer-readable recording medium used in a point service system including a network comprising an award point issuing device that issues points to a customer who purchases an article, a first memory that only stores data of the points issued to the customer (see col 9, lines 55-65) from at least one virtual store, and wherein the recording medium stores the points issued or reduced by any of the at least one virtual store and the at least one actual store (see col 9, lines 55-65). Postrel fails to teach a second memory that only stores data of the points issued to the customer from at least one actual store, a tie-up company comprising the first and second memories, a data access permitting device that permits the data of the points issued to the customer to be

read from the first and second memories and a point reducing device that allows use of at least a part of the points read from the first and second memories by subtracting the at least part of the points from the data of the points stored in the first and second memories, the recording medium comprising: a first working file that stores points and a second working files that stores information identifying the tie-up company, wherein the recording medium transmits and receives the data of the points to and from the first and second memories via the data access permitting device. However, Taylor teaches a smart card that stores point information from a plurality of vendors in different memories areas linked to said vendors and where said points are used as payment for purchases (see col 3, lines 20-40; col 7, lines 35-50). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Postrel's smart card would have a plurality of memories which would store point information from a plurality of vendors, as taught by Taylor in order to link awarded points with the issuing vendor of said awarded points and use said awarded points from different vendors as payment for purchases.

Claim 28, Postrel teaches:

comprising an IC card having an IC chip (see col 9, lines 55-65).

Claim 29, Postrel teaches:

An award point service management method for use with an award point service system comprising the steps of issuing points to a customer who purchases an article in at least one of virtual stores established on a network;

recording the issued points in the first memory (see col 9, lines 55-65); and

subtracting points used by the customer in at least one of a actual stores from the data of the points stored in the first memory such that the points are used by the customer for purchasing an article in the at least one of actual stores (see col 9, lines 55-65).

Postrel fails to teach a network comprising a tie-up company having a first memory that only stores points relating to purchases made by the customer in at least one of virtual stores and a second memory that only stores points relating to purchases made by the customer in at least one actual store, the tie-up company managing points issued to users from a plurality of stores. However, Taylor teaches a smart card that stores point information from a plurality of vendors in different memories areas linked to said vendors and where said points are used as payment for purchases (see col 3, lines 20-40; col 7, lines 35-50). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Postrel's smart card would have a plurality of memories which would store point information from a plurality of vendors, as taught by Taylor in order to link awarded points with the issuing vendor of said awarded points and use said awarded points from different vendors as payment for purchases.

Claim 30, Postrel teaches:

An award point service management method for use with an award point service system comprising the steps of:

issuing points to a customer who purchases an article in at least one of actual stores (see col 9, lines 55-65);

recording the issued points in the second memory (see col 9, lines 55-65);

Postrel fails to teach having a network comprising a tie-up company having a first memory that only stores points relating to purchases made by the customer in at least one virtual store and a second memory that only stores points relating to purchases made by the customer in at least one actual store, the tie-up company managing points issued to users from a plurality of stores and transferring at least a portion of the points in the second memory to the first memory and subtracting points used by the customer in at least one of virtual stores from the data of the points stored in the first memory such that the points are used by the customer for purchasing an article in the at least one of virtual stores. However, Taylor teaches a smart card that stores point information from a plurality of vendors in different memories areas linked to said vendors and where said points are used as payment for purchases (see col 3, lines 20-40; col 7, lines 35-50). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Postrel's smart card would have a plurality of memories which would store point information from a plurality of vendors, as taught by Taylor in order to link awarded points with the issuing vendor of said awarded points and use said awarded points from different vendors as payment for purchases.

Claims 31 and 34, Postrel fails to teach:

wherein the first memory stores points issued by two or more virtual stores and the second memory stores points issued by two or more actual stores. However, Taylor teaches a smart card that stores points issued from stores that accepts visa, American-express cards (see figure 1). Therefore, it would have been obvious to a person of

ordinary skill in the art at the time the application was made, to know that Postrel's smart card would use the Taylor system to stores points from a plurality of virtual or actual stores in the memory of said card.

Claims 32 and 35, Postrel fails to teach:

wherein all of the points issued by virtual stores are stored in the first memory and all of the points issued by actual stores are stored in the second memory. However, Taylor teaches a smart card that stores points from different vendors in said smart card memory and where each vendor has each own section in said smart card (see figure 1). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Postrel's smart card would use the Taylor system to stores points from a plurality of virtual or actual stores in a memory of said card in order to differentiate between different vendors that provided with said points.

Claims 33 and 36, Postrel fails to teach:

at least one tie-up company comprising the first and second memories. However, Taylor teaches a smart card where a single company (i.e. visa) can occupy different memories to stores different points in said card (see figure 4, "visa debit and credit"). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Postrel would use the Taylor system to stores points from a plurality of virtual or actual stores in a memory of a smart card in order to differentiate the source of said earned points.

Claim 37, Postrel teaches:

wherein the managing device comprises:

a switching server connected to the network which controls the points issued by the point issuing device and the points reduced by the point reducing device to ensure that the operation costs of the award point service system born by each of the at least one actual store and at least one virtual store are proportional to the use made of the award point service system by the store (see col 6, lines 40-50). Postrel's reward server convey consideration to the trading server in the form of monetary credit based upon the number of points the reward server has to disburse.

Claim 38, Postrel does not teach:

a credit company registration device that enables the customer to apply to a credit card company to obtain a credit card as part of registering to join the award point service system, the credit registration device providing the customer with acceptance by the credit card company during the registration process when the customer is qualified by the credit card company. However, Official Notice is taken that it is old and well known in the promotion art to register to obtain credit cards and to be qualified for said obtaining. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that users of Postrel's credit card linked to points accounts would need to register for said credit cards, as it is old and well known to register and being qualified for a credit card.

Response to Arguments

5. Applicant's arguments filed 07/31/2008 have been fully considered but they are not persuasive. The Applicant argues with respect to the section 112 1st paragraph rejection, that the Applicant's specification has support for describing how the system

distinguishes between actual store award points and virtual store award points because according to the Applicant, one of ordinary skill would have known that a merchant's computer would necessarily distinguish between a purchase resulting from a POS terminal and a purchase resulting from the Internet by the different hardware and software connections. The Examiner answers that the Applicant is arguing about limitation not stated in the claims as nowhere in the claims or specification is recited that what distinguish an actual store from a virtual store is the different software and hardware use. Furthermore, Official Notices is taken that it is old and well known in the promotion art that merchant's stores use Intranets' systems in their POS systems which have that use the same hardware and software for purchase resulting from the Internet. Therefore, contrary to Applicant argument, the Applicant's specification is not showing support for the above limitation.

The Applicant argues with respect to Section 112 rejection 2nd paragraph that the Examiner's interpretation of claims 1 and 19 that a memory of actual store is a smart card and that a memory of a virtual is a reward server is incorrect because Applicant's memories are both network accessible. The Examiner answers that Postrel's smart card (see col 9, lines 55-65) and reward server (see col 9, lines 1-15) are also network accessible. Therefore, contrary to Applicant's argument, Postrel teaches Applicant's claimed invention.

The Applicant argues that Postrel does not teach claim 37. The Examiner answers that Postrel teaches that a reward server convey consideration to the trading server in the form of monetary credit based upon the number of points the reward

server has to disburse (see col 6, lines 40-52). Therefore, contrary to Applicant's argument, Postrel's rewards servers cost in participating in the Postrel's system is proportional to the amount said reward server has to disburse and therefore, contrary to Applicant's argument, Postrel teaches Applicant's claimed invention.

The Applicant argues that Postrel does not teach any memory that stores points only for virtual stores or that stores points only for actual stores. The Examiner answers that points stored in the Postrel's smart cards are points stores for actual stores and points stored in the Postrel's reward server are points stored in a virtual store (see col 9, lines 1-67) as Applicant's specification defines points stores in IC cards as actual store points (see paragraph 53) and points stored in a remote server as points stored in a virtual store (see paragraph 35) and Taylor teaches that it is old and well known in the promotion art to have a smart card that stores point information from a plurality of vendors in different memories areas linked to said vendors and where said points are used as payment for purchases (see col 3, lines 20-40; col 7, lines 35-50). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Postrel's smart card would have a plurality of memories which would store point information from a plurality of vendors, as taught by Taylor in order to link awarded points with the issuing vendor of said awarded points and use said awarded points from different vendors as payment for purchases. Therefore, contrary to Applicant's argument, Postrel and Taylor teach Applicant's claimed invention.

The Applicant argues that if a smart card is used, the resulting award points may be stored on the smart card as an alternative to storing them on the corresponding merchant-specific reward server, however, according to the Applicant, because smart cards can be used on the Internet and in actual stores, there is no separation, according to the Applicant, of award points based on the virtual or actual nature of purchase by use of Postrel's smart card. The Examiner answers that Postrel's reward server is the memory that stores virtual points and Postrel's smart card is the memory that stores points awarded from actual stores (see col 9, lines 1-67). Therefore, contrary to Applicant's argument, Postrel and Taylor teach Applicant's claimed invention.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 571-272-6720 and fax 571-273-6720. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James W. Myhre can be reached on (571)272-6722. The official Fax number is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Raquel Alvarez/
Primary Examiner, Art Unit 3688

/DANIEL LASTRA/
Examiner, Art Unit 3688
October 21, 2008.